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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,540	02/10/2004	Shinsuke Okada	P24587	1084
7055	7590	10/04/2005	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			KASZTEJNA, MATTHEW JOHN	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/774,540

Applicant(s)

OKADA ET AL.

Examiner

Matthew J. Kasztejna

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-18 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-7, 15-18 and 21-23 is/are rejected.
- 7) ☒ Claim(s) 8-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Notice of Amendment***

In response to the amendment filed on July 18, 2005, amended claims 2-4 and 16-17; canceled claims 1 and 19-20; and new claims 21-23 are acknowledged. The current rejection of claims 1-20 are *withdrawn*. The new grounds of rejection are set forth:

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 recites the limitation "cover member" in line 4 of claim 15. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 101***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2-7, 15-18 and 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,066,090 to Yoon.

**In regards to claim 2**, Yoon discloses an endoscope comprising: an inserting tube 12 to be inserted into a human body; a first optical system 44 secured in a tip end of the inserting tube for observing in vivo tissues within a human body at a first magnification; and a second optical system 46 secured in the tip end of the inserting tube for observing the in vivo tissues at a second magnification that is higher than the first magnification, wherein a portion of the second optical system is within the field of view of the first optical system (see Col. 5, Lines 28-50 and Col. 9, Lines 47-51).

**In regards to claim 3**, Yoon discloses an endoscope, comprising a tip body mounted on a distal end of the inserting tube, the tip body holding the first optical system and the second optical system (see Fig. 3).

**In regards to claim 4**, Yoon discloses an endoscope comprising: an inserting tube 12 to be inserted into a human body; a first optical system 44 secured in a tip end of the inserting tube for observing in vivo tissues within a human body at a first magnification; and a second optical system secured in the tip end of the inserting tube for observing the in vivo tissues at a second magnification that is higher than the first magnification, wherein the first optical system and the second optical system are provided on an end surface of the tip body, the second optical system being arranged such that at least a front end portion thereof is protruded with respect to the first optical system (see Col. 5, Lines 28-50 and Col. 9, Lines 47-51).

**In regards to claims 5-6**, Yoon discloses an endoscope, wherein the first optical system is arranged such that a front end portion thereof is substantially flush with respect to the end surface of the tip body and wherein an optical axis of the first optical

system and an optical axis of the second optical system are substantially parallel with each other (see Fig. 3).

**In regards to claim 7**, Yoon discloses an endoscope, wherein the second optical system is arranged not to interfere with a central area of the field of view of the first optical system (see Col. 5, Lines 33-50).

**In regards to claims 16 and 21**, Yoon discloses an endoscope, wherein the second optical system is inherently capable of being a confocal optical system (see Col. 9, Lines 1-57).

**In regards to claims 17 and 22**, Yoon discloses an endoscope, further comprising: an imaging device provided in the tip end of the inserting tube, and wherein the first optical system forms an image of a target on the imaging device (see Col. 8, Line 39 – Col. 9, Line 47).

**In regards to claims 18 and 23**, Yoon discloses an endoscope, further comprising an optical fiber that transmits light returned from the in vivo tissues, only the light from a level of a focal plane of the second optical system being transmitted through the optical fiber (see Col. 8, Line 39 – Col. 9, Line 47).

***Allowable Subject Matter***

Claims 8-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone

Art Unit: 3739

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJK *mk*  
9/28/05

*Beverly M. Flanagan*  
BEVERLY M. FLANAGAN  
PRIMARY EXAMINER